

R E M A R K S

Applicants respectfully point out that Examiner errs in construing the teachings of Collins and Amano in the following respects.

1. Collins steam generator 416 is not centrally located (as required by applicants' claim 1). Catalyst 424 is centrally located in Collins, and generator 416 extends about 424.

2. Examiner admits that low temperature shift reactor catalyst 438 is located within tubes 414 in Collins. Those spaced apart tubes 414 (see Fig. 4) and catalyst do not extend helically about central catalyst 424. Therefore Collins does not suggest subparagraph c) of applicants' claim 1.

3. Examiner quotes Collins col. 12, lines 31-33, as follows:

"It is also possible to arrange the low temperature shift reactors to be on the shell side of the heat exchanger and pass the reactants through the tube side of the heat exchanger."

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as support for a re-locating of heat exchanger 416. However, note that the Collins quote refers to a heat exchanger, not a steam generator. Therefore, the quote does not support a steam generator re-location. (In fact, Collins at col. 12, lines 33-39 refers to a steam generator and a heat exchanger as separate elements.)

4. Examiner refers to Collins col. 12, lines 33-39 generalized statements as to operation as suggesting applicant's claim 1 sub-paragraph c) structural reference to flow guide surfaces extending helically through the catalyst bed; i.e. about the steam generator. However Examiner's functional interpretation of Collins is not a structural interpretation.

5. Examiner asserts it would be obvious to ''select'' the flow guide surfaces of Amano as an appropriate ''suitable heat exchanger arrangement in Collins ....'' at page 4 of the Action. However please note:

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re

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Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the Examiner to provide a reason (which Examiner has not done) why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the applicants' disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. In re Gordon, 733 F.2d 900, 902 221 USPQ 1125, 1127 (Fed. Cir. 1984).

6. While Examiner at pages 5-6 of the Action refers to claims 2, 3-5, and 7-12, Examiner has

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not given reasons to support rejection of claim 6. Also, the above case criteria for unobviousness are not met by Examiner's discussion of claims 2-5 and 7-12, and particularly with respect to claims 7, 9 and 10.

7. Regarding ¶4 of the Action, Examiner again refers to col. 12, lines 33-39 of Collins; however, the inadequacy of these lines is shown above in 3., 4. and 5.

8. At page 8 of the Action, Examiner refers to the test for obviousness. What examiner omits is what is referred to above in 5., i.e. ''It is incumbent upon Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference, or to combine reference teachings to arrive at the claimed invention.''

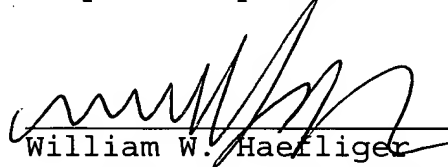
Examiner has not done this and has not pointed to anything in Collins or Amano that would suggest their modification or combination to meet applicant's claims. The Collins and Amano reference patentees each appear well satisfied with their disclosed devices, and indisposed to modify or combine them in such a way or

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ways as to arrive at applicant's claimed invention.  
See also the REMARKS in the prior amendment, and  
attached further comments of the inventor. Prickett is  
no more pertinent than either Amano or Collins.

Allowance is respectfully urged. A call from  
Examiner to discuss any issue, in the interest of  
enhancing prosecution, is invited.

Respectfully submitted,



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